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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,094	01/07/2004	Walter Frazier	740928-140	2316
22204	7590	08/15/2006	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			PHAN, HAU VAN	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/752,094

Applicant(s)

FRAZIER ET AL.

Examiner

Hau V. Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Acknowledgment*

1. The amendment filed on 7/6/2006 has been entered.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 10 and 12, the phrase "the same" is not clear.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 3-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Burns et al. (5,823,543).**

Burns et al. in figures 4-6, disclose an in-line roller skate comprising a boot (13e) for receiving the foot of a user. The boot includes a heel portion, a middle portion, a toe

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portion and a bottom portion. Burns et al. also disclose an outsole (not number, as shown in figures 4 and 6) disposed along the bottom portion of the boot. The outsole includes a toe section. Burn et al. also disclose a chassis (20c or 20e) including a pair of elongated, parallel frames attached to the bottom portion of the skate. The frames have opposed front and rear ends and wherein the frames are connected at the front ends only by an axle of one of the wheels (figure 6). Burns et al. also disclose a recess (not number, as shown in figures 4, 6) disposed in the outsole of the boot at the toe section and a plurality of wheels (22c, 24c, 26c, 28c) mounted on the chassis, at least one of the plurality of wheels being partially recessed within the recess of the outsole.

Regarding claim 3, Burns et al. disclose a first wheel (22c), which mounted on the chassis at the toe portion of the boot.

Regarding claim 4, Burns et al. disclose the first wheel, which is partially disposed within the recess.

Regarding claim 5, Burns et al. disclose a second wheel, which is mounted on the chassis behind the first wheel.

Regarding claim 6, Burns et al. disclose the first and second wheels, which are partially extend into the recess.

Regarding claim 7, Burns et al. disclose the second wheel, which is partially disposed within the recess.

Regarding claim 8, Burns et al. disclose the plurality of wheels having the same size diameter.

Regarding claim 10, Burns et al. disclose each of the frame including a front and rear bracket for mounting the frame to the outsole.

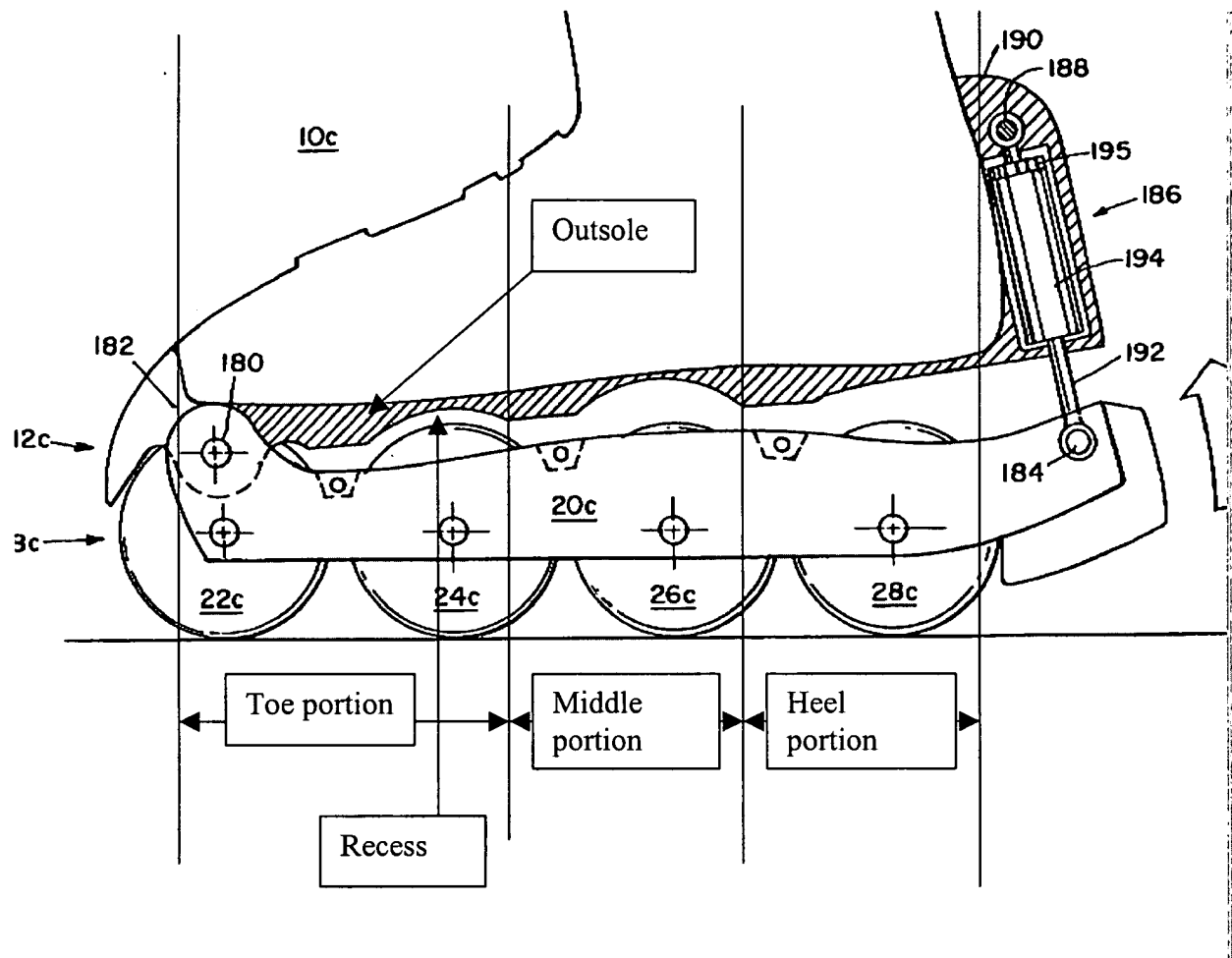
Regarding claim 11, Burns et al. disclose each the front bracket that is mounted to the toe section of the outsole on a side of the recess such that the recess is located between the front mounting brackets of the frame.

Regarding claim 12, Burns et al. disclose each of the frames including a front and rear bracket for mounting the bracket to the outsole.

Regarding claim 13, Burns et al. disclose each of the front brackets that are mounted to the toe section of the outsole on a side of the recess such that the recess is located between the front mounting brackets of the frame.

### ***Response to Arguments***

6. Applicant's arguments filed 7/6/2006 have been fully considered but they are not persuasive. In response to applicant's remark that Burn does not disclose the recess in the outsole of the boot at the toe section. The Examiner disagrees, because Burn et al. in figures 4 and 6, disclose recess in the outsole of the boot at the toe section (see below figures 4 and 6).



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on 571-272-6914. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hau V Phan  
Primary Examiner  
Art Unit 3618

*Hau Phan*  
*8/11/06*